

Appl. No.: 10/627,562
Amdt. dated 12/16/2005
Reply to Office Action of 10/05/2005

REMARKS/ARGUMENTS

In the Office Action dated October 5, 2005, Claims 1-27 are pending, of which Claims 1-20 have been elected for prosecution. The remaining Claims 21-27 are cancelled above. Claims 1, 2, 10-12, 19, and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,533,063 to Buchner, et al. Claims 3-5, 13, and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Buchner, et al. in view of U.S. Patent No. 4,687,116 to Dutt, et al. The remaining Claims 6-9 and 15-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Buchner, et al. In addition, Claims 10, 11, 19, and 20 are rejected under 35 U.S.C. § 112, second paragraph.

Independent Claims 1 and 12 are amended above, as are dependent Claims 10, 19, and 20. New Claims 28-31 are added. Reconsideration is respectfully requested in light of the following comments.

First, regarding the rejection under 35 U.S.C. § 112, second paragraph, each of Claims 10, 19, and 20 is amended above to address the concerns raised by the Examiner. In particular, the terms "said outer membrane" and "said outer membrane portion" have been amended to more clearly refer to "said outer portion of said membrane" as used in Claim 1. Claim 11 is cancelled. Accordingly, Applicant submits that the rejection under 35 U.S.C. § 112 has been addressed. The Examiner's careful attention to this detail of the claims is appreciated.

Applicant now addresses the rejections under 35 U.S.C. § 102. As amended, Claim 1 is directed to an easy-opening, retortable container that includes a base portion with an opening and a single-layer plastic membrane for covering the opening. The membrane defines first and second sides and has coplanar inner and outer portions. The outer portion is friction welded to the base portion. Further, a grip portion is integral to the plastic membrane and disposed on the second side of the membrane and connected to the inner portion. An annular groove disposed in the membrane defines an annular fail portion between the inner and outer portions of the membrane so that the inner portion is structured to be removed from the outer portion by urging the grip portion away from the outer portion, thereby tearing the annular fail portion and opening the container.

The feature of the outer portion of the membrane being friction welded to the base portion was previously set forth in Claim 11. In that regard, the Office Action states that "Claim

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11 is a product-by-process claim and does not further structurally limit the claimed invention. MPEP 2113." Office Action at page 3. Applicant respectfully disagrees. MPEP 2113 states that product-by-process claims are limited by and defined by the claimed process and that the determination of patentability is based on the product itself. (Citing *In re Thorpe*, 777 F.2d 695, 698.) In fact, the same section of the MPEP states:

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product.

MPEP 2113, Eighth edition, revision 2 (May 2004) (citing *In re Garnero*, 412 F.2d 276, 279). Indeed, in *In re Garnero*, the court stated that a phrase such as "interbonded one to another by interfusion" is capable of being construed as a structural limitation rather than a process limitation, just as other phrases including "intermixed," "ground in place," "press fitted," "etched," and "welded," have also been held to be structural limitations. See *In re Garnero* at 279 (emphasis added). Thus, the court held the correct inquiry to be "whether the product defined by claim 1 is patentably distinguishable over the disclosures of [the prior art] in view of the structural limitation defining the panel as "consisting essentially of expanded perlite particles * * * interbonded one to another by interfusion between the surfaces of the perlite particles." *Id.*

Similarly, the "friction welded" language of the present claims provides a structural limitation. That is, the friction weld of the present invention is structurally different and distinguishable from other bonds formed, e.g., by adhesives or press fits. The Examiner has not suggested any other way to define the claimed product, and Applicant submits that the product can be best defined as claimed, even if the feature is considered to be a product-by-process limitation. Accordingly, Applicant respectfully submits that the relevant question in this application is "whether the product defined by [the claims] is patentably distinguishable over the disclosures of [the prior art] in view of the structural limitation," similar to the legal conclusion made by the *In re Garnero* court.

Turning now to the references cited in support of the rejection under § 102(b), Applicant asserts that the claimed invention is indeed patentably distinguishable over Buchner, et al. when the structural limitations of the claims are considered. Buchner, et al. is directed to a lid that is

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molded of a composite material that includes "an outer carrier layer of plastic, a middle barrier layer of metal foil and an inner heat-sealing layer of a thermoplastic synthetic material."

Abstract. The inner layer 16 is formed of a "heat-sealable plastic" so that the inner layer 16 can be heat sealed or welded to the body and acts as an insulating layer. Col. 2, lines 26-45. Neither Buchner, et al. nor the other cited references teach or suggest such a lid that is friction welded to a base portion.

Further, Buchner, et al. fails to disclose other features of the invention as presently claimed. In particular, Claim 1 as amended recites a "single-layer plastic membrane." That is, the membrane is formed of a single layer of plastic, as shown, e.g., in Figures 3 and 4 of the present application. Buchner, et al., on the other hand, describes a lid made of a composite, i.e., multi-layered material that includes an outer plastic carrier layer, a middle metal barrier layer, and an inner heat-sealing layer. Buchner, et al. provides specific requirements for its lid that would not be met without such a multi-layer structure. In particular, Buchner, et al. discloses a weakened line 21 that is "disposed solely in the outer carrier layer 14 and either completely or nearly completely penetrates the thickness thereof in the form of an indentation 22. The indentation 22 is heat-impressed into the carrier layer 14 by means of a heated indenting tool. . . ." Col. 2, lines 54-61. In fact, Buchner, et al. specifically states that other composite materials can be used "so long as the carrier layer comprises a thermoplastic synthetic material and the melting temperature of the layer adjacent to it is higher than that of the carrier layer." Buchner, et al. does not teach or suggest a single-layer membrane. Further, in light of the specific requirements set forth by Buchner, et al. for a multi-layered composite material, it would not have been obvious to substitute a single-layer membrane as claimed, even in light of the other cited references.

Claim 1 also recites that the grip portion is "integral to said plastic membrane." For example, the application describes that the closure 30 can be formed as an integral member by injection or blow molding plastic in a mold that defines the pull ring 50 as well as the inner and outer membrane portions 44, 46. In contrast, Buchner, et al. discloses that "a heat-sealable gripping tab 25, made from a sheet of plastic, is welded to the plastic layer 14." Col. 3, lines 15-19. Indeed, it is not clear how such a gripping tab could be made integrally with the lid without significantly complicating the lamination of the layers of the lid of Buchner, et al.

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For each of the above reasons, it is respectfully submitted that Claim 1 is allowable over Buchner, et al.

Similarly, Claim 12 as amended is directed to an easy-opening closure that includes a single-layer plastic membrane and is therefore patentable over Buchner, et al. for the same reason. In addition, Claim 12 recites that the grip portion is integral to the plastic membrane and further recites that the grip portion is disposed on an opposite side of the membrane from the annular groove, both of which are features not disclosed by Buchner, et al. Accordingly, Applicant submits that Claim 12 as amended is also allowable.

The dependent claims are allowable for the same reasons. Further, the various dependent claims provide additional bases of distinction over the cited references. For example, Claim 10 recites that "said outer portion of said membrane defines a circumferential ridge extending from said first side of said membrane, said ridge structured to engage said base portion of the container." Dependent Claim 19 includes a similar feature. Such a ridge is illustrated and described in the present application, e.g., the circular ridge 60 shown in Figure 3, which "can be provided at an outer periphery of the outer membrane portion 46, the ridge 60 corresponding in diameter to the side 14 so that the ridge 60 can be connected thereto." Page 7, lines 4-10. Buchner, et al. does not describe such a ridge. In addition, this feature is further defined in new Claims 28 and 30. For example, Claim 28 recites that "said circumferential ridge extends in a continuous circular path from said first side of said outer portion of said membrane, said ridge defining a tapered profile and corresponding in diameter to said side of said base portion, and said ridge being friction welded to said side of said base portion." This feature of a circular ridge with a tapered profile for forming the friction weld to the base portion, which is illustrated in Figures 3 and 4 of the present application, is not taught or suggested by the cited references. Newly added Claims 29 and 31 (dependent on Claims 1 and 12, respectively) further recite that "said grip portion is formed during molding of said plastic membrane such that said grip portion is integral to said plastic membrane." As discussed above in connection with Claim 1, Buchner, et al. does not teach or suggest such an integral grip portion.

With regard to Dutt, et al., which is cited as a secondary reference in connection with the rejections of Claims 3-5, 13, and 14 under 35 U.S.C. § 103(a), Applicant respectfully submits that Dutt, et al. fails to cure the deficiencies of Buchner, et al. noted above. In particular, Dutt, et

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al. discloses a closure assembly 10 that includes a clamping rim 14 that is positioned on an open-mouthed container. Col. 5, lines 16-28. In fact, Dutt, et al. specifically describes a closure that is attached "solely by frictional cooperation" as requiring an easy open end closure so that the entire container end does not separate from the container during opening. See col. 1, lines 55-67. In any case, Dutt, et al. does not teach or suggest a friction welded bond as claimed. Further, as discussed above in connection with Claim 1, it would not have been obvious to substitute a single-layer plastic membrane for the multiple-layer composite material of Buchner, et al., even in light of Dutt, et al. Nor does Dutt, et al. disclose the above-noted feature of dependent Claims 10, 19, 28, and 30, i.e., regarding the circumferential ridge extending from the plastic membrane, the ridge having a tapered profile and being friction welded to the base according to Claims 28 and 30.

Accordingly, Applicant respectfully submits that the pending Claims 1-10, 12-20, and 28-31 are allowable for the foregoing reasons.

* * * *

CONCLUSIONS

In view of the remarks presented above, Applicant submits that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicant's undersigned attorney in order to resolve any remaining issues.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required

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therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit
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Respectfully submitted,

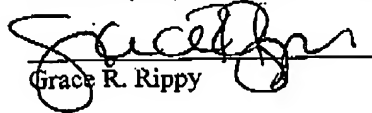


Nicholas F. Gallo
Registration No. 50,135

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111
CLT01/4755623v1

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